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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,124	07/12/2001	DuWayne C. Radke	56908US002	1697

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EXAMINER
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GREEN, CHRISTY MARIE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/904,124

Applicant(s)

RADKE ET AL.

Examiner

Christy M Green

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4, 6, 7, 10, 15, 16, 18 and 19 is/are rejected.  
7) ☒ Claim(s) 5, 11-14, 17 and 20 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is a second office action for the RCE filed for serial number 09/904124, entitled Pass-Through Fire Stop Device, originally filed on July 12, 2001.

#### ***Response to Amendment***

In response to the examiner's office action dated March 3, 2004, the applicant has canceled claims 8-9 and withdrawn claim 21.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1, 2-4, 10 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Radke et al., U.S. Patent No. 6,694,684.

Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,694,684. Although the conflicting claims are not identical, they are not patentably distinct from

each other because each claims a firestop device comprising a housing, firestop material arranged within the housing.

Claims 2-4 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,694,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a firestop device comprising a band including a pull tab that can allow a user to manually remove a band from the housing at a frangible portion; a base portion and a riser portion including a plurality of frangible connections.

Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,694,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a firestop device comprising a riser portion includes a plurality of bands each including a manually engagable pull tab.

Claim 18 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,694,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a firestop device comprising a housing, a base portion, and frangibly connected circumferential bands and a band including a pull tab that can allow a user to manually remove a band from the housing at a frangible portion.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 10, 15-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munzenberger et al., US patent # 6,161,893 in view of Rodriguez, US Patent 5,588,267.

Munzenberger discloses the claimed invention including a firestop device (figure 2) comprising a housing (7), firestop material (11) arranged within the housing; the housing comprising a base portion (3) and a riser portion (7), the base portion including a recess (where 11 points to); the base portion includes a sidewall portion (where 3 points to) extending from a first open end (10) towards the riser portion (7); the sidewall (3) and shoulder (2) portions include inner surfaces having a rib (15); the housing has a first and second opposed open ends (10 and the opposite side of 10) and a hollow chamber (where 12 is located) having a longitudinal axis extending from the first open end to the second open end (figure 2); the first open end (10) is provided in the base portion (where 3 points to) and the second open end is provided in the riser portion (7), the firestop material (11) being provided in spaced relation (by 13) along the sidewall portion inner surface from the first open end to the shoulder portion (figure 2); the housing has a two-tiered cylindrical shape (figure 2) the base portion (3) having a larger diameter than the riser portion (7); the base portion further includes a flange (4) adjacent the first open end (10); the riser portion (7) includes a plurality of equally

Art Unit: 3635

segmented transverse bands (8) each including manually engageable pull tab (where 8 points to); a cap (9) attached to the riser portion (7); the cap contains snap connectors (see attached figure 2) that snap onto the riser portion; a retaining ring (4) arranged within the base portion first open end adjacent the firestop material.

Munzenberger does not disclose the housing including at least one frangible connection defining a removable band. Rodriguez teaches that it is known in the art to provide at least one frangible connection (20) defining a removable band (where 5 points to); and a pull tab (25) providing a grasping means (column 4, lines 28-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the frangible connection of the housing and the pull tab to grasp the band of Rodriguez with the housing of the firestop device of Munzenberger in order to provide different lengths of the housing for different sized walls (column 1, lines 35-37).

#### ***Allowable Subject Matter***

Claims 5, 11-14, 17 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed 6/7/04 have been fully considered but they are not fully persuasive.

In response to applicant's argument that Rodriguez is non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or,

Art Unit: 3635

if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, although Rodriguez reference pertains to a roof flashing, there is a housing (at 1) including the limitations of the applicants invention including teaching at least one frangible connection (20) defining a removable band (where 5 points to); and a pull tab (25) providing a grasping means (column 4, lines 28-34), and therefore is considered to be readable on the applicants invention. The Rodriguez reference is used to teach that a pull tab providing a grasping means as well as a removable band due to a frangible section on a similar housing as in the applicants invention. The fact that the applicant states that it is not within the applicant's field of endeavor, namely firestopping; if the prior art structure is capable of performing the intended use (which would be removing a band - in reference to a frangible section, or a grasping means - in reference to a pull tab, then it meets the claim.

In response to applicant's argument that the Rodriguez roof flashing is not designed or intended to be secured to a wooden concrete form, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon impermissible hindsight reconstruction, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christy M Green whose telephone number is 703-308-9693. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cg

September 14, 2004



Carl D. Friedman  
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